UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG SCHABERNACK and MONIKA BANZHAF

Appeal No. 2005-2583
Application No. 09/328,893

On Brief

Before BARRY, LEVY, and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

ON REQUEST FOR REHEARING

Appellants have filed a paper under 37 CFR § 41.52(a)(1) requesting that we reconsider our decision of November 22, 2005, wherein we entered a new grounds of rejection against claim 1 under 35 U.S.C. § 103 as being unpatentable over Bosse in view of Bennett

Initially, we note that this request is filed pursuant to 37 CFR § 41.52(a)(1) which provides:

> Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or

> overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

Appellants argue, on page 3 of the request for rehearing, that the combination of Bennett and Bosse does not suggest the claimed invention. Specifically, appellants assert that Bennett is concerned with a organizing computer memory whereby objects can be swapped between a hard drive and memory. Appellants argue, in the paragraph bridging pages 3 and 4 of the request for rehearing:

> [s]waping of objects to a hard disk is different from storing an object in a database. A database is generally a collection of data arranged into individual records and organized in a way that the records can easily be accessed, managed and updated. A database is hence, searchable. Therefore, no pointer or stub vector [such as used by Bennett] is required as a surrogate in main memory.

We are not persuaded of error in our decision or the new grounds or rejection based upon Bennet and Bosse. Claim 1 recites the limitations "if there is no sufficient memory space, swapping at least one (MO1) of the stored objects (MO1, MO2) out of the memory (MEM) to a database (DB) according to at least one predeterminable criterion (step 130); and reading the requested object (MO*) from the database (DB) and writing it into the memory (MEM) (step 140)." Thus, claim 1 recites swapping objects out of memory to a database. Appellants' arguments rely upon a proffered definition of a data base but does not identify any support for the definition in the appellants' originally filed specification. Our reviewing court has stated that they view "extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons. First, extrinsic evidence by definition is not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1308 75 USPQ2d 1321, 1330 (Fed. Cir. 2005). While we

concur with appellants that one description of a database is as a collection of data arranged in individual records which is searchable, we do not find that appellants' specification provides support for such a narrow definition of the term database. Further, we find that that other definitions of database, which do not require the data to be organized in records or searchable, are more consistent with the disclosure in appellants' originally filed specification. The Dictionary of Computers, Information Processing And Telecommunications, 2nd Edition, provides the following definitions:

> 1) a collection of data fundamental to a system.
> 2) a collection of data fundamental to an enterprise
> 3) a set of data that is sufficient for a given purpose or for one or several given data processing systems.
> 4) a collection of interrelated or independent data items stored together without unnecessary redundancy, to serve one or more applications.
> 5) see relational data base, sub-data base.

None of these definitions require that a database be searchable or that the data be organized in any particular format, only that it is a collection of data. Appellants' specification on page 4 states, "[t]he database DB, which is implemented on a hard disk, contains objects swapped out of the memory." Further, the description of appellants invention on pages 5 through 7 of the originally filed specification discuss writing data to and retrieving data from the database, but make no mention of the searching the database or that it is organized into records. Thus, we consider the scope of claim 1 to be that the database is a collection of data.

As discussed on page 7 in our decision, dated November 22, 2005, we find that Bennett teaches swapping objects into or out of memory as needed. Bennett teaches that the objects are swapped between main memory and bulk memory (e.g. disk memory). See column 1, line 11 and lines 43 through 46. We consider the bulk memory which stores the data to be a database as claimed and described in appellants' specification, as it is a collection of interrelated data. Thus, appellants' arguments have not persuaded us of error in the new grounds of rejection under 37 CFR§ 41.50(b) of claim 1.

Accordingly, while we have granted appellants' request for rehearing to the extent that we have reconsidered our decision, that request is denied with respect to making any changes therein.

DENIED

LANCE LEONARD BARRY)
Administrative Patent Judge)
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STUART S. LEVY) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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ROBERT E. NAPPI)
Administrative Patent Judge)

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